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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,924	05/01/2001	Wayne L. Randell	CNR 5512	3659
7590 01/20/2006 Boddy B. Gillenwater, Esquire BARNES & THORNBURG 600 One Summit Square Fort Wayne,, IN 46802			EXAMINER OYEBISI, OJO O	
			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,924	RANDELL ET AL.	
	Examiner	Art Unit	
	OJO O. OYEBISI	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the applicant's amendment filed on 11/21/05. In the Amendment, the following has occurred: claims 1-39 have been presented for reconsideration. Claims 1-39 have been reconsidered, and claims 1-39 stand rejected in this office action

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Cross (U.S PAT: 6,144,726).

Re claim 1: Cross discloses a computer readable storage medium containing a program element for execution by a biller computing apparatus residing in a data network for implementing an electronic invoice management system, comprising:

a) an invoice generation unit operative for producing data files representative of invoices issued by a biller to respective customer entities; b) a dispute resolution unit in communication with a dispute history data structure holding a plurality of groups of records, each record being descriptive of reasons a prior invoice produced by the invoice generation unit was disputed by a customer entity, each

group of records being associated to a corresponding customer entity; c) said dispute resolution unit being responsive to a message received from a first customer computing unit over the data network and representative of reasons to dispute a new invoice submitted by a given customer entity to: i) locate the group of records in the dispute history data structure corresponding to the given customer entity; ii) create a record from the message representative of reasons to dispute the new invoice from the given customer entity and store the created record in the dispute history data structure (see summary of the invention, also see fig. 9).

Re claim 2: Cross further discloses a computer readable storage medium as wherein said dispute resolution unit is operative to issue a message to the first customer computing unit to cause generation at the first customer computing unit a dispute resolution interface (see fig.9).

Re claim 3: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution interface has a plurality of predetermined choices that an operator at the first customer computing unit can select, each choice being a predetermined reason to dispute an invoice (see summary of the invention, also see fig. 9).

Re claim 4: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution interface has an editable field in which the operator at the first customer computing unit can enter a text message (see summary of the invention, also see fig. 9).

Re claim 5: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution unit is operative to issue to a second customer computing unit a message to cause the generation at the second customer computing unit of a dispute resolution interface, the second computing unit being associated to an operator of the given customer entity (see summary of the invention, also see col. 9, lines 19-67)

Re claim 6: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution interface includes a field displaying information about the new invoice disputed by the given customer entity (see summary of the invention, also see fig.9).

Re claim 7: Cross further discloses a computer readable storage medium as defined supra said dispute resolution unit is operative to issue to a biller computing unit a message to cause the generation at the biller computing unit of a biller dispute resolution interface, the biller computing unit being associated to an operator of the biller(see summary of the invention, also see col. 9, lines 19-67).

Re claim 8: Cross further discloses a computer readable storage medium as defined supra, wherein said biller dispute resolution interface includes a field displaying information about the new invoice disputed by the given customer entity (see summary of the invention, also see col. 9, lines 19-67).

Re claim 9: Cross further discloses a computer readable storage medium as defined wherein said biller dispute resolution interface includes a field linked to said dispute history data structure to display the group of records associated with

the given customer entity (see summary of the invention, also see col. 9, lines 19-67).

Re claim 10: Cross further discloses a computer readable storage medium as defined supra wherein said biller dispute resolution interface includes a filter to perform a filtering function (i.e., searching function) on the group of records associated with the given customer entity (see col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 11: A computer readable storage medium as defined in claim 10, wherein said filter is modifiable allowing an operator at the biller computing unit to specify a filtering function to display only the records in the group of records associated with the given customer entity (i.e., the scope of the search can be limited) that match the filtering function (col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 12: Cross further discloses a computer readable storage medium as defined supra wherein said biller dispute resolution interface includes an editable field in which the operator at the biller computing unit can enter a text string (see col.9, lines 40-50, also see fig.8, element 42).

Re claim 13: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution unit is operative to store in the dispute history data structure the text string entered at the biller computing unit, the text string being stored in association with the record corresponding to the new invoice (col.9, lines 40-51).

Art Unit: 3628

Re claim 14: Cross further discloses a computer readable storage medium as defined supra wherein said dispute resolution unit is operative to issue to a customer computing unit a message to cause the generation at the customer computing unit of a dispute resolution interface, the computing unit being associated to an operator of the given customer entity, said dispute resolution interface including: a) a first field displaying information about the new invoice disputed by the given customer entity (see fig. 7); b) a second field displaying information indicative of the text string entered at the biller computing unit (see col. 9, lines 35-51).

Re claim 15: Cross discloses an electronic invoice management system, comprising: a) a biller machine; b) a customer computing unit; c) a data network interconnecting said biller machine to said customer computing unit; d) said biller machine including (see fig. 1): i) an invoice generation unit operative for producing data files representative of invoices issued by a biller to respective customer entities; ii) a dispute resolution unit in communication with a dispute history data structure holding a plurality of groups of records, each record being descriptive of reasons a prior invoice produced by the invoice generation unit was disputed by a customer entity, each group of records being associated to a corresponding customer entity; iii) said dispute resolution unit being responsive to a message received from said customer computing unit over said data network and representative of reasons to dispute an invoice submitted by a given customer entity to: (1) locate the group of records in the dispute history data

structure corresponding to the given customer entity; (2) create a record from the message representative of reasons to dispute an invoice from the given customer entity and store the created record in the dispute history data structure (see summary of the invention, also see col.9, lines 19-67).

Re claim 16: Cross discloses a system wherein said dispute resolution unit is operative to issue a message to said customer computing unit to cause generation at said customer computing unit a dispute resolution interface (see fig.9).

Re claim 17: Cross further discloses a system as defined supra wherein said dispute resolution interface has a plurality of predetermined choices that an operator at said customer computing unit can select, each choice being a predetermined reason to dispute an invoice (i.e., a dispute report that describes the discrepancy and discrepancy amount, see col.5, lines 43-50, also see fig.7).

Re claim 18: Cross further discloses a system as defined supra wherein said dispute resolution interface has an editable field in which the operator at said customer computing unit can enter a text message (see col.9, lines 40-50, also see fig.8, element 42).

Re claim 19: Cross further discloses a system as defined supra further comprising a biller computing unit operatively connected to said biller machine, said dispute resolution unit being operative to issue to said biller computing unit a message to cause the generation at said biller computing unit of a biller dispute resolution interface (see summary of the invention).

Re claim 20: Cross further discloses a system as defined supra wherein said biller dispute resolution interface includes a field displaying information about the new invoice disputed by the given customer entity (see fig. 7).

Re claim 21: Cross further discloses a system as defined supra wherein said biller dispute resolution interface includes a field linked to said dispute history data structure to display at said biller computing unit the group of records associated with the given customer entity (see summary of the invention, also see col. 9, lines 19-67).

Re claim 22: Cross further discloses a system as defined supra wherein said biller dispute resolution interface includes a filter to perform a filtering function on the group of records associated with the given customer entity (see col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 23: Cross further discloses a system as defined supra wherein said filter is modifiable allowing an operator at the biller computing unit to specify a filtering function to display only the records in the group of records associated with the given customer entity that match the filtering function (col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 24: Cross further discloses a system as defined supra wherein said biller dispute resolution interface includes an editable field in which the operator at the biller computing unit can enter a text string (see col.9, lines 40-50, also see fig.8, element 42).

Art Unit: 3628

Re claim 25: Cross further discloses a system as defined supra wherein said dispute resolution unit is operative to store in the dispute history data structure the text string entered at the biller computing unit, the text string being stored in association with the record corresponding to the new invoice (col.9, lines 40-51).

Re claim 26: Cross further discloses a system as defined supra wherein said dispute resolution unit is operative to issue to said customer computing unit a message to cause the generation at said customer computing unit of a dispute resolution interface, said dispute resolution interface including: a) a first field displaying information about the new invoice disputed by the given customer entity; b) a second field displaying information indicative of the text string entered at the biller computing unit (see fig.7, also see col.9, lines 35-51).

Re claim 27: Cross discloses a method for electronic invoice management comprising: a) generating at a biller machine data files representative of invoices issued by a biller to respective customer entities; b) providing a data structure holding a plurality of groups of records, each record being descriptive of reasons a prior invoice generated at the biller machine was disputed by a customer entity, each group of records being associated to a corresponding customer entity; c) in response to a message to the biller machine issued by a customer computing unit and representative of reasons to dispute an invoice submitted by a given customer entity: i) locating in the data structure the group of records corresponding to the given customer entity; ii) creating a record from the message representative of reasons to dispute an invoice from the given

customer entity and storing the created record in the dispute history data structure (see fig. 1, see summary of the invention, also see col.9, lines 19-67).

Re claim 28: Cross discloses a method as stated supra said method further comprising issuing a message to the customer computing unit to cause generation at the customer computing unit of a dispute resolution interface (see fig.9, also see fig.7).

Re claim 29: Cross discloses a method as stated supra wherein said dispute resolution interface has a plurality of predetermined choices that an operator at the customer computing unit can select, each choice being a predetermined reason to dispute an invoice (i.e., a dispute report that describes the discrepancy and discrepancy amount, see col.5, lines 43-50, also see fig.7).

Re claim 30: Cross discloses a method as stated supra wherein said dispute resolution interface has an editable field in which the operator at the customer computing unit can enter a text message (see col.9, lines 40-50, also see fig.8, element 42).

Re claim 31: Cross discloses a method as stated supra said method further comprising issuing to a biller computing unit a message to cause the generation at the biller computing unit of a biller dispute resolution interface, the biller computing unit being associated to an operator of the biller (see summary of the invention).

Re claim 32: Cross discloses a method as stated supra wherein said biller dispute resolution interface includes a field displaying information about the new

invoice disputed by the given customer entity (see summary of the invention, also see fig.9).

Re claim 33: Cross discloses a method as stated supra wherein said biller dispute resolution interface includes a field linked to said dispute history data structure to display the group of records associated with the given customer entity (see summary of the invention, also see col. 9, lines 19-67).

Re claim 34: Cross discloses a method as stated supra wherein said biller dispute resolution interface includes a filter to perform a filtering function on the group of records associated with the given customer entity (see col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 35: Cross discloses a method as stated supra wherein said filter is modifiable allowing an operator at the biller computing unit to specify a filtering function to display only the records in the group of records associated with the given customer entity that match the filtering function (col.9, lines 25-35, also see col.12, lines 1-15).

Re claim 36: Cross discloses a method as stated supra wherein said biller dispute resolution interface includes an editable field in which the operator at the biller computing unit can enter a text string (see col.9, lines 40-50, also see fig.8, element 42).

Re claim 37: Cross discloses a method as stated supra said method comprising storing in the dispute history data structure the text string entered at the biller computing unit in association with the record corresponding to the new invoice

(col.9, lines 40-51).

Re claim 38: Cross discloses a method as stated supra said method further comprising issuing to a customer computing unit a message to cause the generation at the customer computing unit of a dispute resolution interface, said dispute resolution interface including: a) a first field displaying information about the new invoice disputed by the given customer entity; b) a second field displaying information indicative of the text string entered at the biller computing unit (see fig.7, also see col.9, lines 35-51).

Re claim 39: Cross further discloses an electronic invoice management system comprising: a) means for producing data files representative of invoices issued by a biller to respective customer entities; b) dispute handling means in communication with a dispute history data structure holding a plurality of groups of records, each record being descriptive of reasons a prior invoice produced by the means for producing was disputed by a customer entity, each group of records being associated to a corresponding customer entity; c) said dispute handling means being responsive to a message received from a first customer computing unit over the data network and representative of reasons to dispute a new invoice submitted by a given customer entity to: i) locate the group of records in the dispute history data structure corresponding to the given customer entity; ii) create a record from the message representative of reasons to dispute the new invoice from the given customer entity and store the created record in

the dispute history data structure (see fig.1, summary of the invention, also see col.9, lines 19-67).

Response to Arguments

3. Applicant's arguments filed on 11/21/2005 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that the system in Cross is therefore associated with the customer and assists a customer in managing incoming bills to be paid, and the manner in which the dispute is handled on the biller end is not described in any way in Cross. Actually, Cross does not look at the biller's side of the exchange at all in its system and does not address the problem of managing a dispute from the biller's side.

In response to this argument, the examiner understands that the applicant's claimed invention/apparatus is intended to be employed on the biller's side, and the prior art of record is intended to be employed on the customer's side.

However, since the prior art of record has the same structural limitations as the applicant's claimed apparatus, the prior art of record possesses the ability to work and would work irrespective of the manner in which it is intended to be employed (i.e., would work on either the customer's side or the biller's side). The examiner asserts that the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600